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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,514	10/02/2003	Peter Minko	FA1027 US NA	8249

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EXAMINER	
PARKER, FREDERICK JOHN	

ART UNIT	PAPER NUMBER
1762	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/677,514	MINKO, PETER	
	Examiner	Art Unit	
	Frederick J. Parker	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-5 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-5 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 02 October 2003 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 10-2-03.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. In particular, reference should be made at least to an electrostatic rotary application process.

2. The use of the trademarks Solvesso (p.5) and Micrometallic (P.16) have been noted in this application. They should be capitalized wherever each appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1,2,5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-8 of copending Application No. 10/632784 ('784). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 6 of '784 discloses the same structure of an electrostatically assisted rotary applicator for generic liquid coatings, wherein the instant application cites a specific liquid coating; subsequent curing step of the instant application would have been an obvious step to provide the coatings with bonding, durability, and utility. Dependant claims 7,8 of '784 are the same as instant claims 5 and 2, respectively.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1,5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 is vague and indefinite because the relative term "high" does not convey the intended rotary speed, is not defined by the specification (page 13 merely exemplifies), and would not have been apparent to the skilled artisan.
- Claim 5; "such" on line 5 renders the scope of the claim unclear because it is not apparent if the sequences must be those previously referred to, or ones implied to be the same or similar, e.g. of a broader scope.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Admitted Prior Art (pages 1-2 Specification), hereafter APA, in view of Kazama et al US 5865380.

APA teaches the application of multi-layer coatings to vehicles and auto parts (which would have reasonably been called "industrially mass produced goods" per claim 2), comprising an electrostatic rotary applied color-effect basecoat (encompassing water-based coats) and a pneumatic sprayed protective clear coat thereon, the latter being taught to have lower efficiency due to overspray (and hence greater waste clean-up and disposal as well). It is taught that when electrostatically assisted rotary spraying replaced pneumatic spraying, a coating would be applied but with "less good" optical effects.

Kazama et al teaches rotary atomizing electrostatic coating apparatuses, the third embodiment (col. 11-12) comprising, as shown in fig. 8, a rotary shaft 1 on which

is located spray head/ cup 2 from which paint is discharged and atomized, and discharge electrode 18 having a series of protrusions as in fig. 8 which serves to increase electrostatic discharge current density and hence improve painting efficiency, the very detriment of pneumatic spraying taught by the APA. Such an electrode band which surrounds the spray head 2 would reasonably be called an electrode "ring". It is apparent that the electrode 18 rotates along with spray head 2, about the same rotary shaft (common axis of rotation). It also teaches successful and more efficient paint deposition (clear coat being considered to be merely a colorless paint). Since the previous layers of the APA are electrostatically coated, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of the APA by incorporating the electrostatic rotary apparatus of Kazama et al to provide the advantage of an electrostatic coating method which is more efficient and cost-effective relative to the prior art method.

While curing is not explicitly cited, it is the Examiner's position that curing to provide the liquid coatings with the cited utility is notoriously well-known and conventional in the art; if the Applicant disagrees with this assertion, he must so state with reasons on the record.

While rotating speed of the electrode band is not cited, it would have been apparent to the skilled artisan to optimize speed to the electrode to maximize the corona discharge current applied during the coating process to maximize coating efficiency.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am - 3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meeks Timothy can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp